

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85012455
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><u>Introduction</u></p> <p>The Examining Attorney continues to refuse registration of Applicant's mark BAMF and Design ("Applicant's Mark") for "bicycles, bicycles accessories in the nature of baskets adapted for bicycles and bicycle horns, and structural parts therefor, namely, bottom brackets, brake components, brake sets, cranks, chain rings, chain ring bolts, chain tensioners, chains, cycling trainers, derailleur bolts, derailleurs, drive trains, forks, frames, freewheels, handlebars, handlebar grips, handlebar stems, handlebar tape, headset spacers, hubs, number plates, pedals, pulleys, quick releases, rims, seat clamps, seat posts, seats, spokes, sprockets, stems, tire pumps, tires, truing stands, tubes, and wheels" in Class 012 ("Applicant's Goods") citing Section 2(a) – Immoral or Scandalous Matter. The basis for the Examining Attorney's rejection is that Applicant's Mark is an acronym for the phrase "bad ass mother fucker", that the terms "bad ass" and "mother fucker" are vulgar, and that the design component purportedly symbolizes a hand giving the middle finger, also a vulgar gesture. Applicant respectfully disagrees with the Examining Attorney's conclusion and requests that the refusal to register be withdrawn.</p> <p style="text-align: center;"><u>Correction to Examining Attorney's Assertion</u></p> <p>In the Office Action issued April 27, 2011, the Examining Attorney incorrectly contends that:</p> <p><i>The applicant acknowledges that the language "bad ass mother fucker" is scandalous but argues that the mark BAMF is not scandalous because people do not know that BAMF is the</i></p>	

acronym for “bad ass mother fucker” and therefore the acronym is not scandalous.

Applicant corrects the Examining Attorney’s contention noting that Applicant ***does not*** consider the phrase “bad ass mother fucker” to be scandalous. Applicant reasserts its prior arguments that its mark is an *acronym* symbolizing the phrase “bad ass mother fuckers” and that the phrase itself is not scandalous, particularly in the context of Applicant’s marketplace.

Prior-Registered Marks Containing BAMF Acronym

Applicant calls to the Examining Attorney’s attention several marks containing the BAMF acronym which the U.S. Patent and Trademark Office has considered registrable.

U.S. Trademark Application No. 85/065794 for BAMF STUDIOS was not refused on the basis of 2(a) and was approved for publication. The mark proceeded through the opposition period without contest and was issued a Notice of Allowance. A copy of the Notice of Allowance is attached hereto.

Additionally, the U.S. Patent and Trademark Office granted U.S. Trademark Registration No. 3813299 for BAMF MOUTHGUARDS to owner Boomba Group, LLC. A copy of the Registration certificate is attached hereto. The mark is registered for goods in Class 28: *Athletic equipment, namely, mouth guards*. The owner’s website contains the slogan, “If it doesn’t say BAMF, then you can’t be one.” The website also contains artwork of a fist with the letters B-A-M-F written on the knuckles as well as photos of wrestlers, MMA fighters, boxers, and others giving aggressive facial gestures, bearing their teeth and placing their hands in fists. Screenshots from the Boomba Group LLC’s website are attached hereto. While the owner does not explicitly state that the acronym has any meaning, it can be inferred from the slogan and from the photos and artwork on the website that the acronym BAMF refers to the phrase bad ass mother fucker.” In particular, the slogan, “If it doesn’t say BAMF, then you can’t be one” reveals the meaning of the registrant’s mark. In the portion of the phrase, “then you can’t *be one*” apparently means “then you can’t be [a bad ass mother fucker]”.

The Examining Attorneys did not refuse the marks BAMF STUDIOS or BAMF MOUTHGUARDS from registration, nor did the Examining Attorneys even question the meaning behind the word BAMF. The approval of the BAMF STUDIOS application and the registration of

the BAMF MOUTHGUARDS registration is evidence that the BAMF acronym is not widely understood and moreover, that the term BAMF on its face cannot be considered scandalous or immoral.

The Examining Attorney Has Not Met the Requisite Burden of Proof

Applicant contends that the Examining Attorney has not met the requisite burden of proof to refuse Applicant's mark from registration. The Examining Attorney bears the burden of proving that Applicant's Mark is "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable;...giving offense to the conscience or moral feelings...[or] calling out [for] condemnation." *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 U.S.P.Q.2d 1923 (Fed. Cir. 1994). Additionally, the Examining Attorney is required to show that a substantial portion of the general public would consider the mark at issue to be scandalous in the context of contemporary attitudes and the relevant marketplace. Applicant contends that the Examining Attorney has not met either of these burdens. Moreover, the court in *Mavety* held that where there is ambiguity as to whether a mark is scandalous, that the determination should be resolved in favor of the applicant, passing the mark to publication and allowing any offended group to oppose the mark.

I. The Examining Attorney Has Not Shown that Applicant's Mark is Scandalous

The Examining Attorney has failed to meet the requisite burdens of proof because Applicant's mark does not clearly and explicitly convey anything offensive or scandalous. Anything that might be considered offensive or scandalous is hidden within an acronym and an abstract, indiscernible drawing that on its face, would certainly not be considered scandalous to the average consumer. The acronym is not well-known and is therefore not widely understood to mean anything offensive or scandalous. As a result, there is ambiguity as to whether Applicant's Mark is scandalous and therefore, the Examining Attorney's refusal should be resolved in the favor of the Applicant.

As Applicant has already stated, its mark is an acronym and the individual letters symbolize the phrase "bad ass mother fuckers." However, because Applicant's Mark is an acronym and not a phrase containing profanity, it cannot be said to convey a *clear commercial impression* that is scandalous, vulgar, or causes shock. The acronym is not widely understood to mean anything even

remotely vulgar. The acronym is minimally suggestive of the full meaning of the phrase and is known only to a very limited crowd of individuals.

The Examining Attorney has not met her burden of showing that Applicant's Mark is considered scandalous or vulgar by a substantial portion of the general public because she has not provided evidence showing that BAMF is a widely known acronym. In fact, the Examining Attorney has supplied evidence in support of Applicant's view that BAMF is not widely known or understood to mean anything vulgar. The Examining Attorney's evidence consists of references from obscure dictionaries and Internet websites, all of which are geared toward a mature audience. The Examining Attorney provides no evidence regarding the readers or users of these websites, specifically, whether they are typically visited by members of the general public. While the Examining Attorney found internet evidence that BAMF can mean "bad ass mother fucker", this evidence alone is insufficient to establish that substantial portion of the general public would consider the mark at issue to be scandalous in the context of contemporary attitudes and the relevant marketplace.

Moreover, as Applicant has already demonstrated, a basic Internet search for the term yields results for BAMF as an acronym for "bad ass mother fucker" only in underground, obscure sources and that there is widespread confusion and uncertainty surrounding the meaning of the acronym BAMF. Moreover, in mainstream sources such as Wikipedia, a search for BAMF reveals that "Bamf" relates to a Marvel Comics X-Men character. Furthermore, a search for BAMF on such mainstream acronym databases as Acronym Finder (www.acronymfinder.com) and on Acronym Guide (<http://www.acronym-guide.com/general-acronyms.php>) yields no results for "bad ass mother fucker" or any derivations thereof.

These findings show that the acronym contained within Applicant's Mark is not widely known and therefore, Applicant's Mark does not clearly and explicitly convey anything offensive or scandalous. Because there is ambiguity as to whether Applicant's Mark is scandalous, the Examining Attorney's refusal should be resolved in the favor of the Applicant.

II. The Examining Attorney Fails to Recognize that Applicant's Consumers Do Not Consider Applicant's Mark to be Scandalous

Applicant has already demonstrated that the acronym contained within its mark is not widely known among the general public. Rather, the acronym is known among a limited, mature audience and is not considered vulgar among this audience. Applicant's consumers are among this limited, mature audience who would not consider Applicant's Mark to be vulgar. Applicant is in the business of selling high-quality performance bicycles to a *sophisticated, adult bike rider*. Applicant does not make or market its products to children and specifically appeals to a provocative, thrill-seeking audience. Applicant describes its bikes on its website (www.bamfbikes.com): "We build them for the hairiest, gnarliest, most gut-wrenching treks through the untamed wild; just like you're built for the grittiest dives, the roughest ink shops, and the blackest black metal shows your own personal concrete jungle has to offer. These are not your father's bikes—not by a long shot." A screen shot of Applicant's website is attached hereto. Each of Applicant's bike models are given edgy names such as Full Nelson (a wrestling move), Grappler (a brutal weapon), and Sucker Punch (a violent punch). Additionally, Applicant's website features photos of provocatively dressed women holding bottles of hard liquor, tattoo-emblazoned men wearing bizarre face masks, and a man gesturing with his middle finger. Taken as a whole, the general commercial impression of Applicant's website and business is that Applicant caters to a particular thrill-seeking audience who looks for brands with a sense of danger, non-conformity, and scandal. As a result, when viewed in the context of Applicant's marketplace, Applicant's Mark is certainly not considered scandalous, shocking, offensive, or immoral. In fact, Applicant's Mark is complimentary to Applicant's consumers – Applicant's consumers want to be considered *bad ass mother fuckers*, namely, confident, defiant, and skilled riders of Applicant's high-quality performance bicycles.

Applicant further contends that the individual words comprising the acronym are not offensive to most audiences. The Motion Picture Association of America (MPAA), in its film ratings guide, offers additional guidance on the appropriateness of the term BAMF and the phrase it connotes. Under the MPAA ratings guidelines, a PG rated film may contain profanity, namely the word "ass", and still be appropriate for most audiences, including most children under age 13. Furthermore, the MPAA determines that a PG-13 rated film may contain a single use of the word "fuck" and still qualify as a film appropriate for most audience with the possible exception of some children under age 13, a decision at the parents' discretion. The MPAA's guidance indicates that the words "ass"

and “fuck” are not offensive to most audiences. *Importantly, Applicant does not even use either of these words in its mark, Applicant merely alludes to these words by way of an acronym.*

III. The Examining Attorney Has Not Shown that Applicant’s Highly-Stylized Design Element is Scandalous

The design component of Applicant’s Mark should not be considered vulgar as the Examining Attorney has not provided convincing evidence that the design will be considered scandalous by a substantial composite of the general public. Applicant has already contended that its mark is a highly-stylized design representing a particular hand gesture. However, the design is so highly-stylized that only a discerning person could determine what the design represents. Notably, the Examining Attorney did not raise this issue in the first Office Action, leading us to believe that at first glance, the design is so abstract that it cannot possibly be vulgar on its face.

The Examining Attorney relies on *In re Wilcher Corp.*, 40 U.S.P.Q. 2d 1929, 1933-34 (TTAB 1996) in which an application for DICK HEADS with a “graphic, readily recognizable representation of male genitalia...play[ing] a very dominant role in the commercial impression created by the mark” was refused on the basis of scandalous matter. Applicant’s Mark is easily distinguishable from *Wilcher* because Applicant’s design is neither graphic nor readily recognizable of a particular hand gesture. The design merely suggests at a hand making a particular gesture and *significant imagination* is needed to reach the conclusion that the design in fact symbolizes a hand gesture.

Applicant’s Mark is also distinguishable from the evidence that the Examining Attorney has provided because Applicant’s design is incredibly abstract. The examples provided by the Examining Attorney show clear demarcations of five fingers as well as the curvature of the human hand. Applicant’s design is three vertically-oriented bars which do not clearly convey the human hand. Unlike the design referenced by the Examining Attorney, Applicant’s mark does not have demarcations of five fingers, nor does it contain the shape and/or curvature of the human hand. Applicant’s mark is merely three vertically-oriented rectangles and only loosely suggests that the mark represents a human hand.

The TTAB has rejected marks that *clearly* depict scandalous or immoral matter. Because

Applicant's mark does not *clearly* depict anything scandalous, it should be distinguished from such cases. In a recent case before the TTAB, *In re Luxuria, s.r.o.*, Serial No. 79055664 (September 19, 2011), the Board determined that the applicant's mark, namely, a bottle design in the shape of a hand with a middle finger extended upwards, is vulgar, comprising matter that is scandalous or immoral. The bottle design is a highly-graphic, sculptural, and humanized representation of a human hand gesturing with the middle finger. The bottle design clearly and unmistakably depicts a hand gesturing with the middle finger. During prosecution of that application, the Examining Attorney noted that the bottle "is a realistic humanized depiction of an extended middle finger [that] would be immediately recognizable by the average consumer as 'giving the finger' or 'f--- you.'" The Examining Attorney further noted that the mark in another case, *In re Bad Frog Brewery*, ought to be distinguished from the *Luxuria* bottle design, "the Board is carving out a distinction between clear, realistic and humanized drawing of the middle finger capable of being perceived as scandalous and immoral, on the one hand, and fanciful, albeit realistic looking animals where there is an ambiguity as to whether purchasers would perceive that mark as scandalous and immoral." The Examining Attorney's comments indicate that certain marks, such as the *Luxuria* bottle design, that are clearly and unambiguously humanized depictions of a middle finger, are scandalous and immoral, whereas other marks, where there is ambiguity as to whether purchasers would perceive a mark as scandalous and immoral, should not be characterized as scandalous and immoral.

In the instant case, Applicant's mark is clearly distinguished from the mark in *Luxuria* and there is obvious ambiguity as to how consumers would perceive the mark. Applicant's mark depicts three vertically-oriented rectangles, a larger rectangle flanked by two shorter rectangles. There is nothing about Applicant's mark that is humanized and it can in no way be described as a clear, realistic rendering of a human hand gesturing the middle finger. As previously mentioned, the mark is so stylized and so ambiguous that even the Examining Attorney did not perceive anything immoral or scandalous about Applicant's mark at first glance and did not raise this issue in the first Office Action. Whereas the Board in *Luxuria* found that "there is no question that applicant's design mark is a depiction of a human hand with the middle finger extended upwards", there is a definite distinction

in the case at hand because the average consumer is unlikely to perceive Applicant's mark as a human hand and would not consider Applicant's mark immoral or scandalous. A side-by-side comparison of the *Luxuria* mark and Applicant's mark is attached hereto.

Applicant further notes that its products will be marketed and distributed to customers in normal trade channels for these goods such as the Giantnerd.com website, a website catering to outdoor enthusiasts. Whereas in *Luxuria*, the applicant's goods were to be sold in grocery stores, supermarkets, and vending machines alongside products including CapriSun®, Coca-Cola®, Gerber® Juice, the patrons of which include children, their parents, and grandparents, in the case at hand, Applicant's goods are to be sold in venues where children are highly unlikely to ever patronize. Even if a child, their parents or grandparents, were to patronize a location where Applicant's goods are sold, because Applicant's mark is so stylized, a far cry from the realistic, humanized depiction of a human hand in *Luxuria*, is unlikely that these consumers would identify Applicant's mark as anything remotely immoral or scandalous.

Conclusion

Applicant contends that the Examining Attorney has not met the requisite burden of proof to refuse Applicant's mark from registration. Applicant believes that neither the word nor design component of its mark can be deemed vulgar. The word component is not widely known or understood to mean anything vulgar and when taken in context of Applicant's marketplace and adult, thrill-seeking customer base, the word component is certainly not offensive. Moreover, the design component is so abstract and stylized that on first glance it cannot be considered vulgar. With these submissions, Applicant believes that it established that the instant application is entitled to registration, and it respectfully requests that it be passed to publication

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
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CONVERTED PDF FILE(S) (1 page)	<u>\\TICRS\EXPORT11\IMAGEOUT11\850\124\85012455\xml12\RFR0011.JPG</u>
DESCRIPTION OF EVIDENCE FILE	BAMF STUDIOS Notice of Allowance; BAMF MOUTHGUARDS Registration Certificate; Screenshots from BAMF MOUTHGUARDS website; Comparison of Luxuria mark and Applicant's mark
SIGNATURE SECTION	
RESPONSE SIGNATURE	/saryn e. leibowitz/
SIGNATORY'S NAME	Saryn E. Leibowitz
SIGNATORY'S POSITION	Attorney of Record, New York bar member
DATE SIGNED	10/27/2011
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION	
SUBMIT DATE	Thu Oct 27 12:01:55 EDT 2011
TEAS STAMP	USPTO/RFR-38.105.182.18-2 0111027120155915525-85012 455-480cc5b5ccca6ac59dce8 c49fd9d9114a-N/A-N/A-2011 1027115721015893

PTO Form (Rev 4/2000)

OMB No. 0651-.... (Exp. 08/31/2004)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **85012455** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Introduction

The Examining Attorney continues to refuse registration of Applicant's mark BAMF and Design ("Applicant's Mark") for "bicycles, bicycles accessories in the nature of baskets adapted for bicycles and bicycle horns, and structural parts therefor, namely, bottom brackets, brake components, brake sets, cranks, chain rings, chain ring bolts, chain tensioners, chains, cycling trainers, derailleur bolts, derailleurs, drive trains, forks, frames, freewheels, handlebars, handlebar grips, handlebar stems, handlebar tape, headset spacers, hubs, number plates, pedals, pulleys, quick releases, rims, seat clamps, seat posts, seats, spokes, sprockets, stems, tire pumps, tires, truing stands, tubes, and wheels" in Class 012 ("Applicant's Goods") citing Section 2(a) – Immoral or Scandalous Matter. The basis for the Examining Attorney's rejection is that Applicant's Mark is an acronym for the phrase "bad ass mother fucker", that the terms "bad ass" and "mother fucker" are vulgar, and that the design component purportedly symbolizes a hand giving the middle finger, also a vulgar gesture. Applicant respectfully disagrees with the Examining Attorney's conclusion and requests that the refusal to register be

withdrawn.

Correction to Examining Attorney's Assertion

In the Office Action issued April 27, 2011, the Examining Attorney incorrectly contends that:

The applicant acknowledges that the language "bad ass mother fucker" is scandalous but argues that the mark BAMF is not scandalous because people do not know that BAMF is the acronym for "bad ass mother fucker" and therefore the acronym is not scandalous.

Applicant corrects the Examining Attorney's contention noting that Applicant **does not** consider the phrase "bad ass mother fucker" to be scandalous. Applicant reasserts its prior arguments that its mark is an *acronym* symbolizing the phrase "bad ass mother fuckers" and that the phrase itself is not scandalous, particularly in the context of Applicant's marketplace.

Prior-Registered Marks Containing BAMF Acronym

Applicant calls to the Examining Attorney's attention several marks containing the BAMF acronym which the U.S. Patent and Trademark Office has considered registrable.

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The Examining Attorneys did not refuse the marks BAMF STUDIOS or BAMF

MOUTHGUARDS from registration, nor did the Examining Attorneys even question the meaning behind the word BAMF. The approval of the BAMF STUDIOS application and the registration of the BAMF MOUTHGUARDS registration is evidence that the BAMF acronym is not widely understood and moreover, that the term BAMF on its face cannot be considered scandalous or immoral.

The Examining Attorney Has Not Met the Requisite Burden of Proof

Applicant contends that the Examining Attorney has not met the requisite burden of proof to refuse Applicant's mark from registration. The Examining Attorney bears the burden of proving that Applicant's Mark is "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable;...giving offense to the conscience or moral feelings...[or] calling out [for] condemnation." *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 U.S.P.Q.2d 1923 (Fed. Cir. 1994). Additionally, the Examining Attorney is required to show that a substantial portion of the general public would consider the mark at issue to be scandalous in the context of contemporary attitudes and the relevant marketplace. Applicant contends that the Examining Attorney has not met either of these burdens.

Moreover, the court in *Mavety* held that where there is ambiguity as to whether a mark is scandalous, that the determination should be resolved in favor of the applicant, passing the mark to publication and allowing any offended group to oppose the mark.

I. The Examining Attorney Has Not Shown that Applicant's Mark is Scandalous

The Examining Attorney has failed to meet the requisite burdens of proof because Applicant's mark does not clearly and explicitly convey anything offensive or scandalous. Anything that might be considered offensive or scandalous is hidden within an acronym and an abstract, indiscernible drawing that on its face, would certainly not be considered scandalous to the average consumer. The acronym is not well-known and is therefore not widely understood to mean anything offensive or scandalous. As a result, there is ambiguity as to whether Applicant's Mark is scandalous and therefore, the Examining Attorney's refusal should be resolved in the favor of the Applicant.

As Applicant has already stated, its mark is an acronym and the individual letters symbolize the phrase "bad ass mother fuckers." However, because Applicant's Mark is an acronym and not a phrase containing profanity, it cannot be said to convey a *clear commercial impression* that is scandalous,

vulgar, or causes shock. The acronym is not widely understood to mean anything even remotely vulgar. The acronym is minimally suggestive of the full meaning of the phrase and is known only to a very limited crowd of individuals.

The Examining Attorney has not met her burden of showing that Applicant's Mark is considered scandalous or vulgar by a substantial portion of the general public because she has not provided evidence showing that BAMF is a widely known acronym. In fact, the Examining Attorney has supplied evidence in support of Applicant's view that BAMF is not widely known or understood to mean anything vulgar. The Examining Attorney's evidence consists of references from obscure dictionaries and Internet websites, all of which are geared toward a mature audience. The Examining Attorney provides no evidence regarding the readers or users of these websites, specifically, whether they are typically visited by members of the general public. While the Examining Attorney found internet evidence that BAMF can mean "bad ass mother fucker", this evidence alone is insufficient to establish that substantial portion of the general public would consider the mark at issue to be scandalous in the context of contemporary attitudes and the relevant marketplace.

Moreover, as Applicant has already demonstrated, a basic Internet search for the term yields results for BAMF as an acronym for "bad ass mother fucker" only in underground, obscure sources and that there is widespread confusion and uncertainty surrounding the meaning of the acronym BAMF. Moreover, in mainstream sources such as Wikipedia, a search for BAMF reveals that "Bamf" relates to a Marvel Comics X-Men character. Furthermore, a search for BAMF on such mainstream acronym databases as Acronym Finder (www.acronymfinder.com) and on Acronym Guide (<http://www.acronym-guide.com/general-acronyms.php>) yields no results for "bad ass mother fucker" or any derivations thereof.

These findings show that the acronym contained within Applicant's Mark is not widely known and therefore, Applicant's Mark does not clearly and explicitly convey anything offensive or scandalous. Because there is ambiguity as to whether Applicant's Mark is scandalous, the Examining Attorney's refusal should be resolved in the favor of the Applicant.

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mark, Applicant merely alludes to these words by way of an acronym.

III. The Examining Attorney Has Not Shown that Applicant's Highly-Stylized Design Element is Scandalous

The design component of Applicant's Mark should not be considered vulgar as the Examining Attorney has not provided convincing evidence that the design will be considered scandalous by a substantial composite of the general public. Applicant has already contended that its mark is a highly-stylized design representing a particular hand gesture. However, the design is so highly-stylized that only a discerning person could determine what the design represents. Notably, the Examining Attorney did not raise this issue in the first Office Action, leading us to believe that at first glance, the design is so abstract that it cannot possibly be vulgar on its face.

The Examining Attorney relies on *In re Wilcher Corp.*, 40 U.S.P.Q. 2d 1929, 1933-34 (TTAB 1996) in which an application for DICK HEADS with a "graphic, readily recognizable representation of male genitalia...play[ing] a very dominant role in the commercial impression created by the mark" was refused on the basis of scandalous matter. Applicant's Mark is easily distinguishable from *Wilcher* because Applicant's design is neither graphic nor readily recognizable of a particular hand gesture. The design merely suggests at a hand making a particular gesture and *significant imagination* is needed to reach the conclusion that the design in fact symbolizes a hand gesture.

Applicant's Mark is also distinguishable from the evidence that the Examining Attorney has provided because Applicant's design is incredibly abstract. The examples provided by the Examining Attorney show clear demarcations of five fingers as well as the curvature of the human hand. Applicant's design is three vertically-oriented bars which do not clearly convey the human hand. Unlike the design referenced by the Examining Attorney, Applicant's mark does not have demarcations of five fingers, nor does it contain the shape and/or curvature of the human hand. Applicant's mark is merely three vertically-oriented rectangles and only loosely suggests that the mark represents a human hand.

The TTAB has rejected marks that *clearly* depict scandalous or immoral matter. Because Applicant's mark does not *clearly* depict anything scandalous, it should be distinguished from such cases. In a recent case before the TTAB, *In re Luxuria, s.r.o.*, Serial No. 79055664 (September 19,

2011), the Board determined that the applicant's mark, namely, a bottle design in the shape of a hand with a middle finger extended upwards, is vulgar, comprising matter that is scandalous or immoral. The bottle design is a highly-graphic, sculptural, and humanized representation of a human hand gesturing with the middle finger. The bottle design clearly and unmistakably depicts a hand gesturing with the middle finger. During prosecution of that application, the Examining Attorney noted that the bottle "is a realistic humanized depiction of an extended middle finger [that] would be immediately recognizable by the average consumer as 'giving the finger' or 'f--- you.'" The Examining Attorney further noted that the mark in another case, *In re Bad Frog Brewery*, ought to be distinguished from the *Luxuria* bottle design, "the Board is carving out a distinction between clear, realistic and humanized drawing of the middle finger capable of being perceived as scandalous and immoral, on the one hand, and fanciful, albeit realistic looking animals where there is an ambiguity as to whether purchasers would perceive that mark as scandalous and immoral." The Examining Attorney's comments indicate that certain marks, such as the *Luxuria* bottle design, that are clearly and unambiguously humanized depictions of a middle finger, are scandalous and immoral, whereas other marks, where there is ambiguity as to whether purchasers would perceive a mark as scandalous and immoral, should not be characterized as scandalous and immoral.

In the instant case, Applicant's mark is clearly distinguished from the mark in *Luxuria* and there is obvious ambiguity as to how consumers would perceive the mark. Applicant's mark depicts three vertically-oriented rectangles, a larger rectangle flanked by two shorter rectangles. There is nothing about Applicant's mark that is humanized and it can in no way be described as a clear, realistic rendering of a human hand gesturing the middle finger. As previously mentioned, the mark is so stylized and so ambiguous that even the Examining Attorney did not perceive anything immoral or scandalous about Applicant's mark at first glance and did not raise this issue in the first Office Action. Whereas the Board in *Luxuria* found that "there is no question that applicant's design mark is a depiction of a human hand with the middle finger extended upwards", there is a definite distinction in the case at hand because the average consumer is unlikely to perceive Applicant's mark as a human hand and would not consider Applicant's mark immoral or scandalous. A side-by-side comparison of the *Luxuria* mark and Applicant's mark is attached hereto.

Applicant further notes that its products will be marketed and distributed to customers in normal trade channels for these goods such as the Giantnerd.com website, a website catering to outdoor enthusiasts. Whereas in *Luxuria*, the applicant's goods were to be sold in grocery stores, supermarkets, and vending machines alongside products including CapriSun®, Coca-Cola®, Gerber® Juice, the patrons of which include children, their parents, and grandparents, in the case at hand, Applicant's goods are to be sold in venues where children are highly unlikely to ever patronize. Even if a child, their parents or grandparents, were to patronize a location where Applicant's goods are sold, because Applicant's mark is so stylized, a far cry from the realistic, humanized depiction of a human hand in *Luxuria*, is unlikely that these consumers would identify Applicant's mark as anything remotely immoral or scandalous.

Conclusion

Applicant contends that the Examining Attorney has not met the requisite burden of proof to refuse Applicant's mark from registration. Applicant believes that neither the word nor design component of its mark can be deemed vulgar. The word component is not widely known or understood to mean anything vulgar and when taken in context of Applicant's marketplace and adult, thrill-seeking customer base, the word component is certainly not offensive. Moreover, the design component is so abstract and stylized that on first glance it cannot be considered vulgar. With these submissions, Applicant believes that it established that the instant application is entitled to registration, and it respectfully requests that it be passed to publication

EVIDENCE

Evidence in the nature of BAMF STUDIOS Notice of Allowance; BAMF MOUTHGUARDS Registration Certificate; Screenshots from BAMF MOUTHGUARDS website; Comparison of Luxuria mark and Applicant's mark has been attached.

Original PDF file:

http://tgate/PDF/RFR/2011/10/27/20111027120155915525-85012455-004_001/evi_3810518218-115721015_._BAMF_STUDIOS_NOA.pdf

Converted PDF file(s) (2 pages)

Evidence-1

Evidence-2

Original PDF file:

http://tgate/PDF/RFR/2011/10/27/20111027120155915525-85012455-004_002/evi_3810518218-115721015_._BAMF_MOUTHGUARDS_Reg_Cert.pdf

Converted PDF file(s) (1 page)

Evidence-1

Original PDF file:

http://tgate/PDF/RFR/2011/10/27/20111027120155915525-85012455-004_003/evi_3810518218-115721015_._BAMF_Mouthguard_Screenshots.pdf

Converted PDF file(s) (6 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Original PDF file:

http://tgate/PDF/RFR/2011/10/27/20111027120155915525-85012455-004_004/evi_3810518218-115721015_._Luxuria_-_BAMF.pdf

Converted PDF file(s) (1 page)

Evidence-1

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /saryn e. leibowitz/ Date: 10/27/2011

Signatory's Name: Saryn E. Leibowitz

Signatory's Position: Attorney of Record, New York bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85012455

Internet Transmission Date: Thu Oct 27 12:01:55 EDT 2011

TEAS Stamp: USPTO/RFR-38.105.182.18-2011102712015591

5525-85012455-480cc5b5ccca6ac59dce8c49fd

9d9114a-N/A-N/A-20111027115721015893

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85012455
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><u>Introduction</u></p> <p>The Examining Attorney continues to refuse registration of Applicant's mark BAMF and Design ("Applicant's Mark") for "bicycles, bicycles accessories in the nature of baskets adapted for bicycles and bicycle horns, and structural parts therefor, namely, bottom brackets, brake components, brake sets, cranks, chain rings, chain ring bolts, chain tensioners, chains, cycling trainers, derailleur bolts, derailleurs, drive trains, forks, frames, freewheels, handlebars, handlebar grips, handlebar stems, handlebar tape, headset spacers, hubs, number plates, pedals, pulleys, quick releases, rims, seat clamps, seat posts, seats, spokes, sprockets, stems, tire pumps, tires, truing stands, tubes, and wheels" in Class 012 ("Applicant's Goods") citing Section 2(a) – Immoral or Scandalous Matter. The basis for the Examining Attorney's rejection is that Applicant's Mark is an acronym for the phrase "bad ass mother fucker", that the terms "bad ass" and "mother fucker" are vulgar, and that the design component purportedly symbolizes a hand giving the middle finger, also a vulgar gesture. Applicant respectfully disagrees with the Examining Attorney's conclusion and requests that the refusal to register be withdrawn.</p> <p style="text-align: center;"><u>Correction to Examining Attorney's Assertion</u></p> <p>In the Office Action issued April 27, 2011, the Examining Attorney incorrectly contends that: <i>The applicant acknowledges that the language "bad ass mother fucker" is scandalous but argues that the mark BAMF is not scandalous because people do not know that BAMF is the</i></p>	

acronym for “bad ass mother fucker” and therefore the acronym is not scandalous.

Applicant corrects the Examining Attorney’s contention noting that Applicant ***does not*** consider the phrase “bad ass mother fucker” to be scandalous. Applicant reasserts its prior arguments that its mark is an *acronym* symbolizing the phrase “bad ass mother fuckers” and that the phrase itself is not scandalous, particularly in the context of Applicant’s marketplace.

Prior-Registered Marks Containing BAMF Acronym

Applicant calls to the Examining Attorney’s attention several marks containing the BAMF acronym which the U.S. Patent and Trademark Office has considered registrable.

U.S. Trademark Application No. 85/065794 for BAMF STUDIOS was not refused on the basis of 2(a) and was approved for publication. The mark proceeded through the opposition period without contest and was issued a Notice of Allowance. A copy of the Notice of Allowance is attached hereto.

Additionally, the U.S. Patent and Trademark Office granted U.S. Trademark Registration No. 3813299 for BAMF MOUTHGUARDS to owner Boomba Group, LLC. A copy of the Registration certificate is attached hereto. The mark is registered for goods in Class 28: *Athletic equipment, namely, mouth guards*. The owner’s website contains the slogan, “If it doesn’t say BAMF, then you can’t be one.” The website also contains artwork of a fist with the letters B-A-M-F written on the knuckles as well as photos of wrestlers, MMA fighters, boxers, and others giving aggressive facial gestures, bearing their teeth and placing their hands in fists. Screenshots from the Boomba Group LLC’s website are attached hereto. While the owner does not explicitly state that the acronym has any meaning, it can be inferred from the slogan and from the photos and artwork on the website that the acronym BAMF refers to the phrase bad ass mother fucker.” In particular, the slogan, “If it doesn’t say BAMF, then you can’t be one” reveals the meaning of the registrant’s mark. In the portion of the phrase, “then you can’t *be one*” apparently means “then you can’t be [a bad ass mother fucker]”.

The Examining Attorneys did not refuse the marks BAMF STUDIOS or BAMF MOUTHGUARDS from registration, nor did the Examining Attorneys even question the meaning behind the word BAMF. The approval of the BAMF STUDIOS application and the registration of

the BAMF MOUTHGUARDS registration is evidence that the BAMF acronym is not widely understood and moreover, that the term BAMF on its face cannot be considered scandalous or immoral.

The Examining Attorney Has Not Met the Requisite Burden of Proof

Applicant contends that the Examining Attorney has not met the requisite burden of proof to refuse Applicant's mark from registration. The Examining Attorney bears the burden of proving that Applicant's Mark is "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable;...giving offense to the conscience or moral feelings...[or] calling out [for] condemnation." *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 U.S.P.Q.2d 1923 (Fed. Cir. 1994). Additionally, the Examining Attorney is required to show that a substantial portion of the general public would consider the mark at issue to be scandalous in the context of contemporary attitudes and the relevant marketplace. Applicant contends that the Examining Attorney has not met either of these burdens. Moreover, the court in *Mavety* held that where there is ambiguity as to whether a mark is scandalous, that the determination should be resolved in favor of the applicant, passing the mark to publication and allowing any offended group to oppose the mark.

I. The Examining Attorney Has Not Shown that Applicant's Mark is Scandalous

The Examining Attorney has failed to meet the requisite burdens of proof because Applicant's mark does not clearly and explicitly convey anything offensive or scandalous. Anything that might be considered offensive or scandalous is hidden within an acronym and an abstract, indiscernible drawing that on its face, would certainly not be considered scandalous to the average consumer. The acronym is not well-known and is therefore not widely understood to mean anything offensive or scandalous. As a result, there is ambiguity as to whether Applicant's Mark is scandalous and therefore, the Examining Attorney's refusal should be resolved in the favor of the Applicant.

As Applicant has already stated, its mark is an acronym and the individual letters symbolize the phrase "bad ass mother fuckers." However, because Applicant's Mark is an acronym and not a phrase containing profanity, it cannot be said to convey a *clear commercial impression* that is scandalous, vulgar, or causes shock. The acronym is not widely understood to mean anything even

remotely vulgar. The acronym is minimally suggestive of the full meaning of the phrase and is known only to a very limited crowd of individuals.

The Examining Attorney has not met her burden of showing that Applicant's Mark is considered scandalous or vulgar by a substantial portion of the general public because she has not provided evidence showing that BAMF is a widely known acronym. In fact, the Examining Attorney has supplied evidence in support of Applicant's view that BAMF is not widely known or understood to mean anything vulgar. The Examining Attorney's evidence consists of references from obscure dictionaries and Internet websites, all of which are geared toward a mature audience. The Examining Attorney provides no evidence regarding the readers or users of these websites, specifically, whether they are typically visited by members of the general public. While the Examining Attorney found internet evidence that BAMF can mean "bad ass mother fucker", this evidence alone is insufficient to establish that substantial portion of the general public would consider the mark at issue to be scandalous in the context of contemporary attitudes and the relevant marketplace.

Moreover, as Applicant has already demonstrated, a basic Internet search for the term yields results for BAMF as an acronym for "bad ass mother fucker" only in underground, obscure sources and that there is widespread confusion and uncertainty surrounding the meaning of the acronym BAMF. Moreover, in mainstream sources such as Wikipedia, a search for BAMF reveals that "Bamf" relates to a Marvel Comics X-Men character. Furthermore, a search for BAMF on such mainstream acronym databases as Acronym Finder (www.acronymfinder.com) and on Acronym Guide (<http://www.acronym-guide.com/general-acronyms.php>) yields no results for "bad ass mother fucker" or any derivations thereof.

These findings show that the acronym contained within Applicant's Mark is not widely known and therefore, Applicant's Mark does not clearly and explicitly convey anything offensive or scandalous. Because there is ambiguity as to whether Applicant's Mark is scandalous, the Examining Attorney's refusal should be resolved in the favor of the Applicant.

II. The Examining Attorney Fails to Recognize that Applicant's Consumers Do Not Consider Applicant's Mark to be Scandalous

Applicant has already demonstrated that the acronym contained within its mark is not widely known among the general public. Rather, the acronym is known among a limited, mature audience and is not considered vulgar among this audience. Applicant's consumers are among this limited, mature audience who would not consider Applicant's Mark to be vulgar. Applicant is in the business of selling high-quality performance bicycles to a *sophisticated, adult bike rider*. Applicant does not make or market its products to children and specifically appeals to a provocative, thrill-seeking audience. Applicant describes its bikes on its website (www.bamfbikes.com): "We build them for the hairiest, gnarliest, most gut-wrenching treks through the untamed wild; just like you're built for the grittiest dives, the roughest ink shops, and the blackest black metal shows your own personal concrete jungle has to offer. These are not your father's bikes—not by a long shot." A screen shot of Applicant's website is attached hereto. Each of Applicant's bike models are given edgy names such as Full Nelson (a wrestling move), Grappler (a brutal weapon), and Sucker Punch (a violent punch). Additionally, Applicant's website features photos of provocatively dressed women holding bottles of hard liquor, tattoo-emblazoned men wearing bizarre face masks, and a man gesturing with his middle finger. Taken as a whole, the general commercial impression of Applicant's website and business is that Applicant caters to a particular thrill-seeking audience who looks for brands with a sense of danger, non-conformity, and scandal. As a result, when viewed in the context of Applicant's marketplace, Applicant's Mark is certainly not considered scandalous, shocking, offensive, or immoral. In fact, Applicant's Mark is complimentary to Applicant's consumers – Applicant's consumers want to be considered *bad ass mother fuckers*, namely, confident, defiant, and skilled riders of Applicant's high-quality performance bicycles.

Applicant further contends that the individual words comprising the acronym are not offensive to most audiences. The Motion Picture Association of America (MPAA), in its film ratings guide, offers additional guidance on the appropriateness of the term BAMF and the phrase it connotes. Under the MPAA ratings guidelines, a PG rated film may contain profanity, namely the word "ass", and still be appropriate for most audiences, including most children under age 13. Furthermore, the MPAA determines that a PG-13 rated film may contain a single use of the word "fuck" and still qualify as a film appropriate for most audience with the possible exception of some children under age 13, a decision at the parents' discretion. The MPAA's guidance indicates that the words "ass"

and “fuck” are not offensive to most audiences. *Importantly, Applicant does not even use either of these words in its mark, Applicant merely alludes to these words by way of an acronym.*

III. The Examining Attorney Has Not Shown that Applicant’s Highly-Stylized Design Element is Scandalous

The design component of Applicant’s Mark should not be considered vulgar as the Examining Attorney has not provided convincing evidence that the design will be considered scandalous by a substantial composite of the general public. Applicant has already contended that its mark is a highly-stylized design representing a particular hand gesture. However, the design is so highly-stylized that only a discerning person could determine what the design represents. Notably, the Examining Attorney did not raise this issue in the first Office Action, leading us to believe that at first glance, the design is so abstract that it cannot possibly be vulgar on its face.

The Examining Attorney relies on *In re Wilcher Corp.*, 40 U.S.P.Q. 2d 1929, 1933-34 (TTAB 1996) in which an application for DICK HEADS with a “graphic, readily recognizable representation of male genitalia...play[ing] a very dominant role in the commercial impression created by the mark” was refused on the basis of scandalous matter. Applicant’s Mark is easily distinguishable from *Wilcher* because Applicant’s design is neither graphic nor readily recognizable of a particular hand gesture. The design merely suggests at a hand making a particular gesture and *significant imagination* is needed to reach the conclusion that the design in fact symbolizes a hand gesture.

Applicant’s Mark is also distinguishable from the evidence that the Examining Attorney has provided because Applicant’s design is incredibly abstract. The examples provided by the Examining Attorney show clear demarcations of five fingers as well as the curvature of the human hand. Applicant’s design is three vertically-oriented bars which do not clearly convey the human hand. Unlike the design referenced by the Examining Attorney, Applicant’s mark does not have demarcations of five fingers, nor does it contain the shape and/or curvature of the human hand. Applicant’s mark is merely three vertically-oriented rectangles and only loosely suggests that the mark represents a human hand.

The TTAB has rejected marks that *clearly* depict scandalous or immoral matter. Because

Applicant's mark does not *clearly* depict anything scandalous, it should be distinguished from such cases. In a recent case before the TTAB, *In re Luxuria, s.r.o.*, Serial No. 79055664 (September 19, 2011), the Board determined that the applicant's mark, namely, a bottle design in the shape of a hand with a middle finger extended upwards, is vulgar, comprising matter that is scandalous or immoral. The bottle design is a highly-graphic, sculptural, and humanized representation of a human hand gesturing with the middle finger. The bottle design clearly and unmistakably depicts a hand gesturing with the middle finger. During prosecution of that application, the Examining Attorney noted that the bottle "is a realistic humanized depiction of an extended middle finger [that] would be immediately recognizable by the average consumer as 'giving the finger' or 'f--- you.'" The Examining Attorney further noted that the mark in another case, *In re Bad Frog Brewery*, ought to be distinguished from the *Luxuria* bottle design, "the Board is carving out a distinction between clear, realistic and humanized drawing of the middle finger capable of being perceived as scandalous and immoral, on the one hand, and fanciful, albeit realistic looking animals where there is an ambiguity as to whether purchasers would perceive that mark as scandalous and immoral." The Examining Attorney's comments indicate that certain marks, such as the *Luxuria* bottle design, that are clearly and unambiguously humanized depictions of a middle finger, are scandalous and immoral, whereas other marks, where there is ambiguity as to whether purchasers would perceive a mark as scandalous and immoral, should not be characterized as scandalous and immoral.

In the instant case, Applicant's mark is clearly distinguished from the mark in *Luxuria* and there is obvious ambiguity as to how consumers would perceive the mark. Applicant's mark depicts three vertically-oriented rectangles, a larger rectangle flanked by two shorter rectangles. There is nothing about Applicant's mark that is humanized and it can in no way be described as a clear, realistic rendering of a human hand gesturing the middle finger. As previously mentioned, the mark is so stylized and so ambiguous that even the Examining Attorney did not perceive anything immoral or scandalous about Applicant's mark at first glance and did not raise this issue in the first Office Action. Whereas the Board in *Luxuria* found that "there is no question that applicant's design mark is a depiction of a human hand with the middle finger extended upwards", there is a definite distinction

in the case at hand because the average consumer is unlikely to perceive Applicant's mark as a human hand and would not consider Applicant's mark immoral or scandalous. A side-by-side comparison of the *Luxuria* mark and Applicant's mark is attached hereto.

Applicant further notes that its products will be marketed and distributed to customers in normal trade channels for these goods such as the Giantnerd.com website, a website catering to outdoor enthusiasts. Whereas in *Luxuria*, the applicant's goods were to be sold in grocery stores, supermarkets, and vending machines alongside products including CapriSun®, Coca-Cola®, Gerber® Juice, the patrons of which include children, their parents, and grandparents, in the case at hand, Applicant's goods are to be sold in venues where children are highly unlikely to ever patronize. Even if a child, their parents or grandparents, were to patronize a location where Applicant's goods are sold, because Applicant's mark is so stylized, a far cry from the realistic, humanized depiction of a human hand in *Luxuria*, is unlikely that these consumers would identify Applicant's mark as anything remotely immoral or scandalous.

Conclusion

Applicant contends that the Examining Attorney has not met the requisite burden of proof to refuse Applicant's mark from registration. Applicant believes that neither the word nor design component of its mark can be deemed vulgar. The word component is not widely known or understood to mean anything vulgar and when taken in context of Applicant's marketplace and adult, thrill-seeking customer base, the word component is certainly not offensive. Moreover, the design component is so abstract and stylized that on first glance it cannot be considered vulgar. With these submissions, Applicant believes that it established that the instant application is entitled to registration, and it respectfully requests that it be passed to publication

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2011/10/27/20111027120155915525-85012455-004_001/evi_3810518218-115721015_._BAMF_STUDIOS_NOA.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT11\IMAGEOUT11\850\124\85012455\xml12\RFR0002.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\850\124\85012455\xml12\RFR0003.JPG
ORIGINAL	http://tgate/PDF/RFR/2011/10/27/20111027120155915525-

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DESCRIPTION OF EVIDENCE FILE	BAMF STUDIOS Notice of Allowance; BAMF MOUTHGUARDS Registration Certificate; Screenshots from BAMF MOUTHGUARDS website; Comparison of Luxuria mark and Applicant's mark
SIGNATURE SECTION	
RESPONSE SIGNATURE	/saryn e. leibowitz/
SIGNATORY'S NAME	Saryn E. Leibowitz
SIGNATORY'S POSITION	Attorney of Record, New York bar member
DATE SIGNED	10/27/2011
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION	
SUBMIT DATE	Thu Oct 27 12:01:55 EDT 2011
TEAS STAMP	USPTO/RFR-38.105.182.18-2 0111027120155915525-85012 455-480cc5b5ccca6ac59dce8 c49fd9d9114a-N/A-N/A-2011 1027115721015893

PTO Form (Rev 4/2000)

OMB No. 0651-.... (Exp. 08/31/2004)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **85012455** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Introduction

The Examining Attorney continues to refuse registration of Applicant's mark BAMF and Design ("Applicant's Mark") for "bicycles, bicycles accessories in the nature of baskets adapted for bicycles and bicycle horns, and structural parts therefor, namely, bottom brackets, brake components, brake sets, cranks, chain rings, chain ring bolts, chain tensioners, chains, cycling trainers, derailleur bolts, derailleurs, drive trains, forks, frames, freewheels, handlebars, handlebar grips, handlebar stems, handlebar tape, headset spacers, hubs, number plates, pedals, pulleys, quick releases, rims, seat clamps, seat posts, seats, spokes, sprockets, stems, tire pumps, tires, truing stands, tubes, and wheels" in Class 012 ("Applicant's Goods") citing Section 2(a) – Immoral or Scandalous Matter. The basis for the Examining Attorney's rejection is that Applicant's Mark is an acronym for the phrase "bad ass mother fucker", that the terms "bad ass" and "mother fucker" are vulgar, and that the design component purportedly symbolizes a hand giving the middle finger, also a vulgar gesture. Applicant respectfully disagrees with the Examining Attorney's conclusion and requests that the refusal to register be

withdrawn.

Correction to Examining Attorney's Assertion

In the Office Action issued April 27, 2011, the Examining Attorney incorrectly contends that:

The applicant acknowledges that the language “bad ass mother fucker” is scandalous but argues that the mark BAMF is not scandalous because people do not know that BAMF is the acronym for “bad ass mother fucker” and therefore the acronym is not scandalous.

Applicant corrects the Examining Attorney's contention noting that Applicant **does not** consider the phrase “bad ass mother fucker” to be scandalous. Applicant reasserts its prior arguments that its mark is an *acronym* symbolizing the phrase “bad ass mother fuckers” and that the phrase itself is not scandalous, particularly in the context of Applicant's marketplace.

Prior-Registered Marks Containing BAMF Acronym

Applicant calls to the Examining Attorney's attention several marks containing the BAMF acronym which the U.S. Patent and Trademark Office has considered registrable.

U.S. Trademark Application No. 85/065794 for BAMF STUDIOS was not refused on the basis of 2(a) and was approved for publication. The mark proceeded through the opposition period without contest and was issued a Notice of Allowance. A copy of the Notice of Allowance is attached hereto.

Additionally, the U.S. Patent and Trademark Office granted U.S. Trademark Registration No. 3813299 for BAMF MOUTHGUARDS to owner Boomba Group, LLC. A copy of the Registration certificate is attached hereto. The mark is registered for goods in Class 28: *Athletic equipment, namely, mouth guards*. The owner's website contains the slogan, “If it doesn't say BAMF, then you can't be one.” The website also contains artwork of a fist with the letters B-A-M-F written on the knuckles as well as photos of wrestlers, MMA fighters, boxers, and others giving aggressive facial gestures, bearing their teeth and placing their hands in fists. Screenshots from the Boomba Group LLC's website are attached hereto. While the owner does not explicitly state that the acronym has any meaning, it can be inferred from the slogan and from the photos and artwork on the website that the acronym BAMF refers to the phrase bad ass mother fucker.” In particular, the slogan, “If it doesn't say BAMF, then you can't be one” reveals the meaning of the registrant's mark. In the portion of the phrase, “then you can't be one” apparently means “then you can't be [a bad ass mother fucker]”.

The Examining Attorneys did not refuse the marks BAMF STUDIOS or BAMF

MOUTHGUARDS from registration, nor did the Examining Attorneys even question the meaning behind the word BAMF. The approval of the BAMF STUDIOS application and the registration of the BAMF MOUTHGUARDS registration is evidence that the BAMF acronym is not widely understood and moreover, that the term BAMF on its face cannot be considered scandalous or immoral.

The Examining Attorney Has Not Met the Requisite Burden of Proof

Applicant contends that the Examining Attorney has not met the requisite burden of proof to refuse Applicant's mark from registration. The Examining Attorney bears the burden of proving that Applicant's Mark is "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable;...giving offense to the conscience or moral feelings...[or] calling out [for] condemnation." *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 U.S.P.Q.2d 1923 (Fed. Cir. 1994). Additionally, the Examining Attorney is required to show that a substantial portion of the general public would consider the mark at issue to be scandalous in the context of contemporary attitudes and the relevant marketplace. Applicant contends that the Examining Attorney has not met either of these burdens.

Moreover, the court in *Mavety* held that where there is ambiguity as to whether a mark is scandalous, that the determination should be resolved in favor of the applicant, passing the mark to publication and allowing any offended group to oppose the mark.

I. The Examining Attorney Has Not Shown that Applicant's Mark is Scandalous

The Examining Attorney has failed to meet the requisite burdens of proof because Applicant's mark does not clearly and explicitly convey anything offensive or scandalous. Anything that might be considered offensive or scandalous is hidden within an acronym and an abstract, indiscernible drawing that on its face, would certainly not be considered scandalous to the average consumer. The acronym is not well-known and is therefore not widely understood to mean anything offensive or scandalous. As a result, there is ambiguity as to whether Applicant's Mark is scandalous and therefore, the Examining Attorney's refusal should be resolved in the favor of the Applicant.

As Applicant has already stated, its mark is an acronym and the individual letters symbolize the phrase "bad ass mother fuckers." However, because Applicant's Mark is an acronym and not a phrase containing profanity, it cannot be said to convey a *clear commercial impression* that is scandalous,

vulgar, or causes shock. The acronym is not widely understood to mean anything even remotely vulgar. The acronym is minimally suggestive of the full meaning of the phrase and is known only to a very limited crowd of individuals.

The Examining Attorney has not met her burden of showing that Applicant's Mark is considered scandalous or vulgar by a substantial portion of the general public because she has not provided evidence showing that BAMF is a widely known acronym. In fact, the Examining Attorney has supplied evidence in support of Applicant's view that BAMF is not widely known or understood to mean anything vulgar. The Examining Attorney's evidence consists of references from obscure dictionaries and Internet websites, all of which are geared toward a mature audience. The Examining Attorney provides no evidence regarding the readers or users of these websites, specifically, whether they are typically visited by members of the general public. While the Examining Attorney found internet evidence that BAMF can mean "bad ass mother fucker", this evidence alone is insufficient to establish that substantial portion of the general public would consider the mark at issue to be scandalous in the context of contemporary attitudes and the relevant marketplace.

Moreover, as Applicant has already demonstrated, a basic Internet search for the term yields results for BAMF as an acronym for "bad ass mother fucker" only in underground, obscure sources and that there is widespread confusion and uncertainty surrounding the meaning of the acronym BAMF. Moreover, in mainstream sources such as Wikipedia, a search for BAMF reveals that "Bamf" relates to a Marvel Comics X-Men character. Furthermore, a search for BAMF on such mainstream acronym databases as Acronym Finder (www.acronymfinder.com) and on Acronym Guide (<http://www.acronym-guide.com/general-acronyms.php>) yields no results for "bad ass mother fucker" or any derivations thereof.

These findings show that the acronym contained within Applicant's Mark is not widely known and therefore, Applicant's Mark does not clearly and explicitly convey anything offensive or scandalous. Because there is ambiguity as to whether Applicant's Mark is scandalous, the Examining Attorney's refusal should be resolved in the favor of the Applicant.

II. The Examining Attorney Fails to Recognize that Applicant's Consumers Do Not Consider Applicant's Mark to be Scandalous

Applicant has already demonstrated that the acronym contained within its mark is not widely known among the general public. Rather, the acronym is known among a limited, mature audience and is not considered vulgar among this audience. Applicant's consumers are among this limited, mature audience who would not consider Applicant's Mark to be vulgar. Applicant is in the business of selling high-quality performance bicycles to a *sophisticated, adult bike rider*. Applicant does not make or market its products to children and specifically appeals to a provocative, thrill-seeking audience.

Applicant describes its bikes on its website (www.bamfbikes.com): "We build them for the hairiest, gnarliest, most gut-wrenching treks through the untamed wild; just like you're built for the grittiest dives, the roughest ink shops, and the blackest black metal shows your own personal concrete jungle has to offer. These are not your father's bikes—not by a long shot." A screen shot of Applicant's website is attached hereto. Each of Applicant's bike models are given edgy names such as Full Nelson (a wrestling move), Grappler (a brutal weapon), and Sucker Punch (a violent punch). Additionally, Applicant's website features photos of provocatively dressed women holding bottles of hard liquor, tattoo-emblazoned men wearing bizarre face masks, and a man gesturing with his middle finger. Taken as a whole, the general commercial impression of Applicant's website and business is that Applicant caters to a particular thrill-seeking audience who looks for brands with a sense of danger, non-conformity, and scandal. As a result, when viewed in the context of Applicant's marketplace, Applicant's Mark is certainly not considered scandalous, shocking, offensive, or immoral. In fact, Applicant's Mark is complimentary to Applicant's consumers – Applicant's consumers want to be considered *bad ass mother fuckers*, namely, confident, defiant, and skilled riders of Applicant's high-quality performance bicycles.

Applicant further contends that the individual words comprising the acronym are not offensive to most audiences. The Motion Picture Association of America (MPAA), in its film ratings guide, offers additional guidance on the appropriateness of the term BAMF and the phrase it connotes. Under the MPAA ratings guidelines, a PG rated film may contain profanity, namely the word "ass", and still be appropriate for most audiences, including most children under age 13. Furthermore, the MPAA determines that a PG-13 rated film may contain a single use of the word "fuck" and still qualify as a film appropriate for most audience with the possible exception of some children under age 13, a decision at the parents' discretion. The MPAA's guidance indicates that the words "ass" and "fuck" are not offensive to most audiences. *Importantly, Applicant does not even use either of these words in its*

mark, Applicant merely alludes to these words by way of an acronym.

III. The Examining Attorney Has Not Shown that Applicant's Highly-Stylized Design Element is Scandalous

The design component of Applicant's Mark should not be considered vulgar as the Examining Attorney has not provided convincing evidence that the design will be considered scandalous by a substantial composite of the general public. Applicant has already contended that its mark is a highly-stylized design representing a particular hand gesture. However, the design is so highly-stylized that only a discerning person could determine what the design represents. Notably, the Examining Attorney did not raise this issue in the first Office Action, leading us to believe that at first glance, the design is so abstract that it cannot possibly be vulgar on its face.

The Examining Attorney relies on *In re Wilcher Corp.*, 40 U.S.P.Q. 2d 1929, 1933-34 (TTAB 1996) in which an application for DICK HEADS with a "graphic, readily recognizable representation of male genitalia...play[ing] a very dominant role in the commercial impression created by the mark" was refused on the basis of scandalous matter. Applicant's Mark is easily distinguishable from *Wilcher* because Applicant's design is neither graphic nor readily recognizable of a particular hand gesture. The design merely suggests at a hand making a particular gesture and *significant imagination* is needed to reach the conclusion that the design in fact symbolizes a hand gesture.

Applicant's Mark is also distinguishable from the evidence that the Examining Attorney has provided because Applicant's design is incredibly abstract. The examples provided by the Examining Attorney show clear demarcations of five fingers as well as the curvature of the human hand. Applicant's design is three vertically-oriented bars which do not clearly convey the human hand. Unlike the design referenced by the Examining Attorney, Applicant's mark does not have demarcations of five fingers, nor does it contain the shape and/or curvature of the human hand. Applicant's mark is merely three vertically-oriented rectangles and only loosely suggests that the mark represents a human hand.

The TTAB has rejected marks that *clearly* depict scandalous or immoral matter. Because Applicant's mark does not *clearly* depict anything scandalous, it should be distinguished from such cases. In a recent case before the TTAB, *In re Luxuria, s.r.o.*, Serial No. 79055664 (September 19,

2011), the Board determined that the applicant's mark, namely, a bottle design in the shape of a hand with a middle finger extended upwards, is vulgar, comprising matter that is scandalous or immoral. The bottle design is a highly-graphic, sculptural, and humanized representation of a human hand gesturing with the middle finger. The bottle design clearly and unmistakably depicts a hand gesturing with the middle finger. During prosecution of that application, the Examining Attorney noted that the bottle "is a realistic humanized depiction of an extended middle finger [that] would be immediately recognizable by the average consumer as 'giving the finger' or 'f--- you.'" The Examining Attorney further noted that the mark in another case, *In re Bad Frog Brewery*, ought to be distinguished from the *Luxuria* bottle design, "the Board is carving out a distinction between clear, realistic and humanized drawing of the middle finger capable of being perceived as scandalous and immoral, on the one hand, and fanciful, albeit realistic looking animals where there is an ambiguity as to whether purchasers would perceive that mark as scandalous and immoral." The Examining Attorney's comments indicate that certain marks, such as the *Luxuria* bottle design, that are clearly and unambiguously humanized depictions of a middle finger, are scandalous and immoral, whereas other marks, where there is ambiguity as to whether purchasers would perceive a mark as scandalous and immoral, should not be characterized as scandalous and immoral.

In the instant case, Applicant's mark is clearly distinguished from the mark in *Luxuria* and there is obvious ambiguity as to how consumers would perceive the mark. Applicant's mark depicts three vertically-oriented rectangles, a larger rectangle flanked by two shorter rectangles. There is nothing about Applicant's mark that is humanized and it can in no way be described as a clear, realistic rendering of a human hand gesturing the middle finger. As previously mentioned, the mark is so stylized and so ambiguous that even the Examining Attorney did not perceive anything immoral or scandalous about Applicant's mark at first glance and did not raise this issue in the first Office Action. Whereas the Board in *Luxuria* found that "there is no question that applicant's design mark is a depiction of a human hand with the middle finger extended upwards", there is a definite distinction in the case at hand because the average consumer is unlikely to perceive Applicant's mark as a human hand and would not consider Applicant's mark immoral or scandalous. A side-by-side comparison of the *Luxuria* mark and Applicant's mark is attached hereto.

Applicant further notes that its products will be marketed and distributed to customers in normal trade channels for these goods such as the Giantnerd.com website, a website catering to outdoor enthusiasts. Whereas in *Luxuria*, the applicant's goods were to be sold in grocery stores, supermarkets, and vending machines alongside products including CapriSun®, Coca-Cola®, Gerber® Juice, the patrons of which include children, their parents, and grandparents, in the case at hand, Applicant's goods are to be sold in venues where children are highly unlikely to ever patronize. Even if a child, their parents or grandparents, were to patronize a location where Applicant's goods are sold, because Applicant's mark is so stylized, a far cry from the realistic, humanized depiction of a human hand in *Luxuria*, is unlikely that these consumers would identify Applicant's mark as anything remotely immoral or scandalous.

Conclusion

Applicant contends that the Examining Attorney has not met the requisite burden of proof to refuse Applicant's mark from registration. Applicant believes that neither the word nor design component of its mark can be deemed vulgar. The word component is not widely known or understood to mean anything vulgar and when taken in context of Applicant's marketplace and adult, thrill-seeking customer base, the word component is certainly not offensive. Moreover, the design component is so abstract and stylized that on first glance it cannot be considered vulgar. With these submissions, Applicant believes that it established that the instant application is entitled to registration, and it respectfully requests that it be passed to publication

EVIDENCE

Evidence in the nature of BAMF STUDIOS Notice of Allowance; BAMF MOUTHGUARDS Registration Certificate; Screenshots from BAMF MOUTHGUARDS website; Comparison of Luxuria mark and Applicant's mark has been attached.

Original PDF file:

http://tgate/PDF/RFR/2011/10/27/20111027120155915525-85012455-004_001/evi_3810518218-115721015_._BAMF_STUDIOS_NOA.pdf

Converted PDF file(s) (2 pages)

Evidence-1

Evidence-2

Original PDF file:

http://tgate/PDF/RFR/2011/10/27/20111027120155915525-85012455-004_002/evi_3810518218-115721015_._BAMF_MOUTHGUARDS_Reg_Cert.pdf

Converted PDF file(s) (1 page)

Evidence-1

Original PDF file:

http://tgate/PDF/RFR/2011/10/27/20111027120155915525-85012455-004_003/evi_3810518218-115721015_._BAMF_Mouthguard_Screenshots.pdf

Converted PDF file(s) (6 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Original PDF file:

http://tgate/PDF/RFR/2011/10/27/20111027120155915525-85012455-004_004/evi_3810518218-115721015_-_Luxuria_-_BAMF.pdf

Converted PDF file(s) (1 page)

Evidence-1

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /saryn e. leibowitz/ Date: 10/27/2011

Signatory's Name: Saryn E. Leibowitz

Signatory's Position: Attorney of Record, New York bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

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